



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of
ANDREW BEROKOFF
For: GOLF CLUB
Serial No. 10/799,124
Filed: 3/15/2004

PATENT
) Art Unit: 3711
) Examiner: S. Blau
)
)
) December 27, 2005

DECLARATION OF DIXIE BULLINGTON

I, Dixie Bullington, declare as follows:

That I am a paralegal employed in the law offices of Averill & Varn, the attorneys of record for the applicant herein. I am responsible for setting appointments for the patent and trademark attorneys and for maintaining all records and files for the patent and trademark clients.

On October 28, 2003, the applicant herein, Andrew Berokoff, came into our office to see Mr. Edgar Averill regarding a new invention for a golf club and presented us with a drawing dated October 6, 2003, and a disclosure dated October 20, 2003. Copies of both of these documents are attached hereto and by this reference incorporated herein.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United

States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing therein.

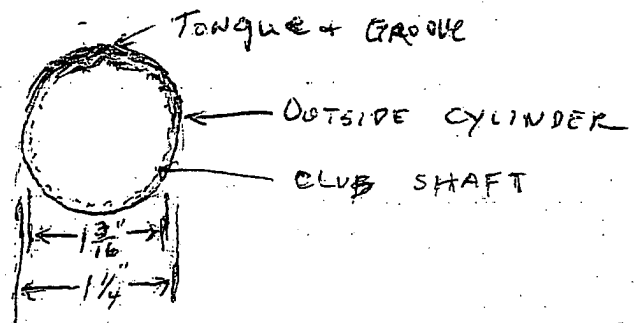
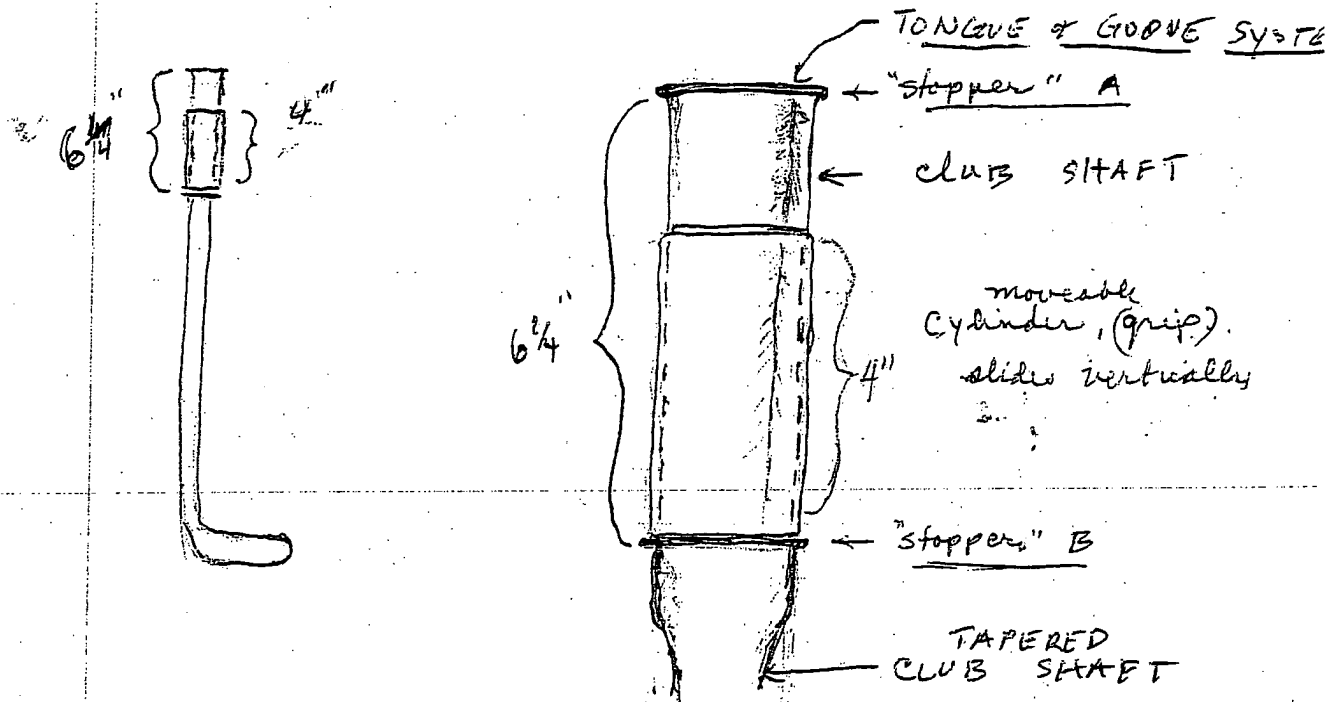
Dated: 12/28, 2005.


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A. BERKOWITZ
"THE NOVEL GOLF PUTTER"

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Andy Bernick 10-6-03

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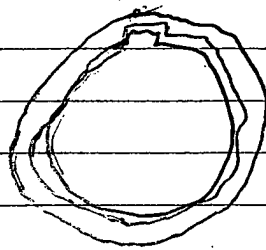
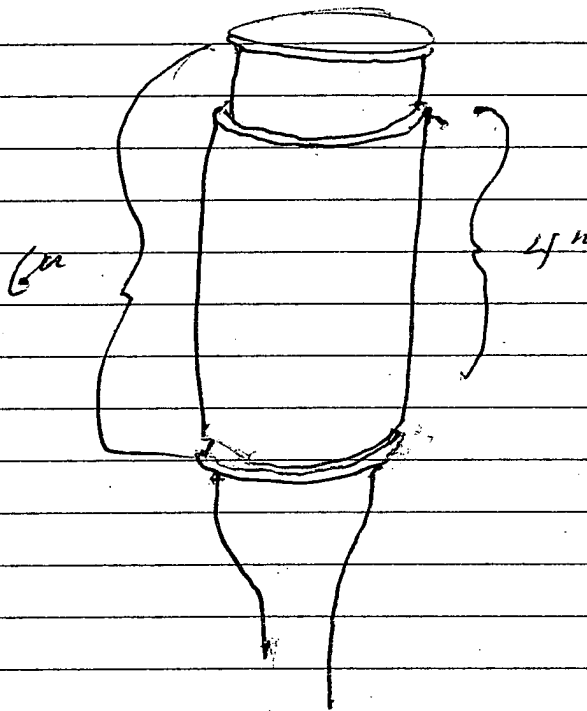
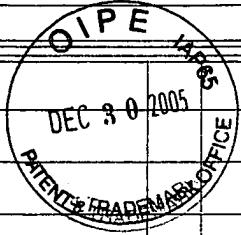
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By W. Berloff
October 28, 2003

"Better Golf Club Shafts"
By Andrew J. Berokoff

October 20, 2003
Whittier, California

This invention is to improve accuracy in hitting a golf ball. It might also improve hitting a golf ball for distance. This is a novel idea because it improves the golf grip for the "woods" the "irons" and for the "putter." There are several claims made.

1. Shafts are normally made to taper to a narrower diameter at the club-head part of a golf club to get a "whip" in the swing. This new way to create the club's "whip" is accomplished by changing the location of the narrowed diameter of the shaft to a position that is near the "grip" part of the shaft. Moreover, a double whip can be accomplished by narrowing the shaft at two points of its length, one at the normal position near the club-head and another at the position just below the grip end.
2. Some golfers would better be served by having a grip handle that would be more like a baseball bat type of handle. In this case, the grip area is made to have a diameter that is one inch or more. The golfer would then grip the golf club as he would a baseball bat.
3. Some golfers would better be served by having the grip section at the upper end of the shaft to be angled in two directions away from the normal straight shaft. This type of grip is angled approximately ten degrees forward, that is, forward toward where the golfer is aiming his shot, and ten degrees down, that is, toward where the golfer's feet are. This angled shaft can be made in the factory to be sold as a new club, or it can be made as an appendage that a player can mechanically attach to his already owned straight-shafted club. The separate piece would be made from some hard but light round stock such as "delrin." The "piece" would be one-and-one-fourth inch in diameter and seven to eleven inches long. A baseball grip would be used to swing the club.
4. Some golfers might be better served by moveable grips. This grip is particularly applicable for use on the shaft of a golf putter club. This grip on a putter shaft would best be made in a factory. It can also be made and sold as a club accessory for a player to install on his used putters. A periscope system attached to the end of a putter shaft is an example of a moveable grip that is made at the factory. Another example of a moveable grip is one that is composed of a cylinder that moves straight up and down the upper end of a shaft, and/or spins on the shaft by using the shaft as its axis. This shaft and grip can be factory made or it can be made as an accessory for attachment on old clubs.

The following is a specific description of a cylinder grip made for a golf putter. This invention is a golf putter that is designed to help the "once-a-week" golfer to habitually execute a "lag putt." In order to achieve this, the grip is constructed in the novel manner described below. This grip is all-inclusive in terms that it can be made for most golf putters (clubs), regardless of their shapes, forms or compositions.

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The novel feature is a freely moving grip at the top end of the club shaft. In total, it includes the upper six-and-one-quarter inches of the shaft. (All arithmetical measurements that are given below can vary.) The grip consists of a cylinder-shaped device at the upper end of the putter's shaft that can move up and down at its upper end. The moving cylinder is four inches long and its wall should be one-sixteenth-of-an-inch or less thick. The inner side of the cylinder must be smooth to permit it to move freely up and down the upper end of the shaft. In this particular variation, the grip is able to move up and down but is not able to spin around the shaft by using it as its axis. The outside diameter of the cylinder, or moving grip, depends on the diameter of the upper end of the shaft. Optimally, the outside diameter of the grip would be one or up to one-and-a-quarter inches. Therefore, the taper in the shaft must stop seven inches below its upper end. Consequently, the last seven inches of the shaft would be of the same diameter, and would have a smooth wall that is fractionally narrower than the inside diameter of the moveable cylinder grip. In other words, although it is to move freely up and down, the cylinder (grip) should not have excessive "play" between it and the putter's shaft. In addition, the up and down movement will be kept constant by some mechanical means, such as by a "bearing" system, or more simply, by a "tongue and groove" system. The movement of the grip up or down would be limited to two inches by means of "stoppers."

Two "stoppers" must be built onto the outside part of the putter's shaft. They would be like a bead of weld, and optimally, they would be the width of a ring on a man's hand. They should be one-sixteenth to one-thirty-two-seconds of an inch thicker than the outside diameter of the moving cylinder. One "stopper" is to be located at the very upper end of the putter's shaft, and the second "stopper" is to be located six-and-one-quarter inches below the upper "stopper." The purpose of the "stoppers" is to prevent the moveable grip from sliding lower than six-and-one-quarter inches from the upper end of the shaft and to prevent the moveable grip from sliding off the top end of the shaft.

The outside of the cylinder can be covered with any of the standard gripping materials already in use for gripping purposes.



Practitioner's Docket No. 134/156

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Application No.: 10 /799,124

Group No.: 3711

Filed: 3/13/2004

Examiner: S. Blau

For: Golf Club

Commissioner for Patents

P.O. Box 1450, Alexandria, VA 22313-1450

**DECLARATION OF PRIOR INVENTION IN THE UNITED STATES
OR IN A NAFTA OR WTO MEMBER COUNTRY
TO OVERCOME CITED PATENT OR PUBLICATION (37 C.F.R. § 1.131)**

NOTE: 37 C.F.R. § 1.131 Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is **mandatory**;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

☒ deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 *

☒ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"

Mailing Label No. _____ (mandatory)

TRANSMISSION

☐ facsimile transmitted to the Patent and Trademark Office, (703) _____

Signature

Date: _____

Kenneth L. Green

(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication—37 C.F.R. § 1.131 [9-32]—page 1 of 5)

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n); or

(2) The rejection is based upon a statutory bar.

PURPOSE OF DECLARATION

1. This declaration is to establish completion of the invention of this application in
- ☒ the United States
 - ☐ the NAFTA country _____ (name of country)
 - ☐ the WIPO country _____ (name of country)
- at a date prior to 3/4/2004, that is the effective date of the prior art
- ☐ publication _____
 - ☒ patent _____
 - ☐ patent publication _____
 - ☒ other patent filing date _____

that was cited by the

- ☒ examiner.
- ☐ applicant.

NOTE: 37 C.F.R. § 1.131 is not applicable to a rejection based on a U.S. patent that CLAIMS the rejected invention.

2. The person making this declaration is (are):
- ☒ the inventor(s).
 - ☐ only some of the joint inventor(s) (and a suitable excuse is attached for failure of the omitted joint inventor(s) to sign)
 - ☐ the party in interest (and a suitable explanation as why it is not possible to produce the declaration of the inventor(s) is attached)

FACTS AND DOCUMENTARY EVIDENCE

NOTE: "The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained." 37 C.F.R. § 1.131(b).

3. To establish the date of completion of the invention of this application, the following attached documents and/or models are submitted as evidence:

(check all applicable items below)

- ☐ sketches
- ☐ blueprints
- ☐ photographs
- ☐ reproduction(s) of notebook entries
- ☐ model
- ☐ supporting statement(s) by witness(es) (where verbal disclosures are the evidence relied upon)
- ☐ interference testimony
- ☒ disclosure documents

NOTE: While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder* 1897 C.D. 724, 81 O.G. 1417." See also M.P.E.P. § 715.07 and § 2138.04, 7th ed.

4. From these documents and/or models, it can be seen that the invention in this application was made

- ☐ on _____
- ☒ at least by the date of 10/28/2003, which is a date earlier than the effective date of the reference.

NOTE: "If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration." M.P.E.P. § 715.07, 8th ed.

NOTE: "[T]he dates in the oath or declaration may be the actual dates, or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided." M.P.E.P. § 715.07, 8th ed.

DILIGENCE

NOTE: "Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of the actual reduction to practice or up to the date of filing his or her application (filing constitutes a **constructive** reduction to practice, § 1.131)." M.P.E.P. § 715.07, 8th ed..

NOTE: "A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS HE OR SHE FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., Limited* 1909 C.D. 498, 139 O.G. 991, M.P.E.P. § 715.07, 8th ed.

"Conception in the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417, it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also." M.P.E.P. § 715.07, 8th ed.

NOTE: "[O]nly diligence before reduction to practice is a material consideration. The 'lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon' is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947)." MPEP § 715.07(a), 8th ed.

(Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication—37 C.F.R. § 1.131 [9-32]—page 3 of 5)

5. Attached is a statement establishing the diligence of the applicants, from the time of their conception, to a time just prior to the date of the reference, up to the:

- ☐ actual reduction to practice.
☒ filing of this application.

TIME OF PRESENTATION OF THE DECLARATION

(complete (a), (b) or (c))

- (a) ☒ This declaration is submitted prior to final rejection.
(b) ☐ This declaration is submitted with the first response after final rejection, and is for the purpose of overcoming a new ground of rejection or requirement made in the final rejection.
(c) ☐ This declaration is submitted after final rejection. A showing under 37 C.F.R. § 1.116(b) is submitted herewith.

DECLARATION

6. As a person signing below:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

SIGNATURE(S)

7. (complete A or B below)

A. Inventor(s)

Full name of sole or first inventor Andrew J. Berokoff

Inventor's signature Andrew J. Berokoff

Date 12/28/05 Country of Citizenship U.S.A.

Residence 13922 Valna Ave., Whittier, CA 90605

Post Office Address Same

Full name of second joint inventor, if any _____

Inventor's signature _____

Date _____ Country of Citizenship _____

Residence _____

Post Office Address _____

(use added page for signature by additional inventors)

Number of pages added: _____

B. Assignee

(type or print name of person signing)

Signature

Date

P.O. Address

(type name of assignee)

Address of assignee

Title of person authorized to sign
on behalf of assignee

Assignment recorded in PTO on _____

Reel _____ Frame _____

A "CERTIFICATE UNDER 37 C.F.R. § 3.73(b)" is attached.

(Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome
Cited Patent or Publication—37 C.F.R. § 1.131 [9-32]—page 5 of 5)